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10/706,361	11/12/2003	James Carlton Bedingfield SR.	60027.0328US01/BS030132	6810

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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2614

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,361

Applicant(s)

BEDINGFIELD, JAMES CARLTON

Examiner

Joseph T. Phan

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5 and 23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 5 and 23 lines 9-10 recites "transmitting the second e-mail received notification message voicemail box" which is unclear and confusing how the 'voicemail box' is related to the 'transmitting'. Appropriate clarification and/or correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-28 rejected under 35 U.S.C. 102(b) as being anticipated by Quinn, Patent #5,944,786.

Regarding claims 1 and 21, Quinn teaches a method and a system(Fig.1-2) for notifying an electronic mail recipient of electronic mail receipt via voicemail messaging, comprising: a subscriber e-mail provider system(Fig.1-2) operative to receive a first electronic mail (e-mail) message at a subscriber e-mail box(col.5 line 58-col.6 line 15); a message notification and consolidation module operative to monitor receipt of the first

electronic mail (e-mail) message at a subscriber e-mail box(col.6 lines 1-5, col.7 lines 55-60, and col.9 lines 51-55);

to construct a first e-mail received notification message(col.7 lines 59-63 and col.9 lines 52-64);

to annotate the first e-mail received notification message with a unique identification tone for identifying the first e-mail received notification message(col.7 lines 24-67 and col.9 lines 1-10);

to transmit the first e-mail received notification message to a subscriber voicemail box(col.7 line 63-col.8 line 6 and col.10 1-7);

to determine whether the first e-mail message is disposed of in the subscriber e-mail box(col.6 lines 1-15, col.9 lines 22-30, and col.10 lines 8-22);

to locate the first e-mail received notification message in the subscriber voicemail box via the unique identification tone(col.9 lines 21-40 and col.10 lines 8-22); and

to delete the first e-mail received notification message from the subscriber voicemail box(col.9 lines 35-40 and col.10 lines 8-22).

Regarding claims 2-4 and 22, Quinn teaches the method and system of claims 1 and 21, the message notification and consolidation module being further operative

to detect the receipt of a second e-mail message at the subscriber e-mail box prior to the disposition of the first e-mail message in the subscriber e-mail box(col.7 lines 55-59 and col.8 lines 55-62);

to search the subscriber voicemail box for a voicemail message having the unique identification tone(col.9 lines 1-10 and col.10 lines 50-59); and

to delete the first e-mail received notification message from the subscriber voicemail box if the second e-mail message is received at the subscriber e-mail box prior to disposition of the first e-

mail message in the subscriber e-mail box(col.6 lines 49-64 and col.8 lines 55-62; Quinn's system can receive multiple email messages which changes/deletes the first email received notification message with a new one).

Regarding claims 5 and 23, Quinn, as best understood due to the 112 confusion above, teaches the method and system of claims 4 and 22, the message notification and consolidation module being further operative after deleting the first e-mail received notification message from the subscriber voicemail box, further comprising:

constructing a second e-mail received notification message containing notification information from both the first e-mail message and the second e-mail(col.8 lines 55-62);
annotating the second e-mail received notification message with a second unique identification tone for identifying the second e-mail received notification message, and
transmitting the second e-mail received notification message voicemail box(col.8 lines 55-62).

Regarding claim 6, Quinn teaches the method of claim 1, whereby receiving the first electronic mail message at the subscriber e-mail box, includes receiving the first e-mail message via an e-mail provider system(col.5 lines 40-67).

Regarding claim 7, Quinn teaches the method of claim 6, prior to the step of receiving a first e-mail message at a subscriber e-mail box, further comprising monitoring the subscriber e-mail box via the e-mail provider system (col.5 line 40-col.6 line 15).

Regarding claim 8, Quinn teaches the method of claim 7, after receiving the first e-mail message at the subscriber e-mail box, obtaining a telephone directory number for the subscriber voicemail box(col.7 lines 1-22).

Regarding claim 9, Quinn teaches the method of claim 8, after obtaining the telephone

directory number for a subscriber voicemail box, obtaining an electronic messaging address for the subscriber voicemail box(col.7 lines 1-67).

Regarding claim 10, Quinn teaches the method of claim 1, after transmitting the first e-mail received notification message to the subscriber voicemail box, activating a voicemail received indication at the subscriber voicemail box(col.7 lines 1-67).

Regarding claim 11 Quinn teaches the method of claim 10, whereby activating a voicemail received indication at the subscriber voicemail box includes activating a voicemail received indication at a subscriber voicemail box access device(col.8 lines 1-38).

Regarding claim 12, Quinn teaches the method of claim 11, whereby the voicemail box access device includes a telephone(Fig.1-2 and col.8 lines 30-67).

Regarding claim 13, Quinn teaches the method of claim 11, whereby the voicemail box access device includes a personal digital assistant(Fig.1-2 and col.8 lines 30-67; device 24/32 is a personal digital assistant).

Regarding claim 14, Quinn teaches the method of claim 7, whereby monitoring the subscriber e-mail box by the e-mail provider system includes monitoring a disposition status of the first e-mail message(col.6 lines 1-15).

Regarding claim 15, Quinn teaches the method of claim 14, whereby monitoring the disposition status of the first e-mail message has been disposed of in the subscriber e-mail box(col.6 lines 1-15).

Regarding claim 16, Quinn teaches the method of claim 15, whereby determining the first e-mail message has been disposed of in the subscriber e-mail box includes determining the first e-mail message has been deleted from the subscriber e-mail box(col.6 lines 1-15 and col.9 lines

22-30).

Regarding claim 17, Quinn teaches the method of claim 15, whereby determining the first e-mail message has been disposed of in the subscriber e-mail box includes determining the first e-mail message has been read(col.6 lines 1-15 and col.9 lines 22-30).

Regarding claim 18, Quinn teaches the method of claim 1, prior to deleting the first e-mail received notification message from the subscriber voicemail box, searching the subscriber voicemail box for the first e-mail notification message by searching for a voicemail message having the unique identification tone(col.9 lines 1-30 and col.10 lines 50-59);

Regarding claim 19, Quinn teaches the method of claim 1, further comprising receiving the first e-mail received notification message at the subscriber voicemail box; and reviewing the first e-mail received notification message by the subscriber(col.8 lines 30-67 and col.9 lines 1-30).

Regarding claim 20, Quinn teaches the method of claim 19, further comprising receiving the second e-mail received notification message at the subscriber voicemail box; and reviewing the second e-mail received notification message by the subscriber(col.8 lines 30-67 and col.9 lines 1-30)

Regarding claim 24, Quinn teaches a method of notifying an electronic mail recipient of electronic mail receipt via voicemail messaging, comprising:
receiving a first electronic mail (e-mail) message at a subscriber e-mail box(col.5 line 58-col.6 line 15 and col.7 lines 55-60);
constructing a first e-mail received notification message(col.7 lines 59-63 and col.9 lines 52-64);
annotating the first e-mail received notification message with a unique identification tone for

identifying the first e-mail received notification message(col.7 lines 24-67 and col.9 lines 1-10);;
transmitting the first e-mail received notification message to a subscriber voicemail box(col.7
line 63-col.8 line 6 and col.10 1-7);

if the first e-mail message is disposed of, locating the first e-mail received notification message
in the subscriber voicemail box via the unique identification tone, and deleting the first e-mail
received notification message from the subscriber voicemail box(col.9 lines 21-40 and col.10
lines 8-22);

monitoring the subscriber e-mail box for receipt of additional e-mail messages(col.7 lines 57-
59); and

if additional e-mail messages are received at the subscriber e-mail box prior to disposition of the
first e-mail message in the subscriber e-mail box, deleting the first e-mail received notification
message from the subscriber voicemail box, and transmitting to the subscriber voicemail box a
consolidated e-mail received notification message containing notification information from both
the first e-mail message and the additional e-mail messages(col.8 lines 55-62).

Regarding claim 25, Quinn teaches the method of claim 24, whereby after prior to
transmitting the consolidated e-mail received notification message, annotating the consolidated
e-mail received notification message with a second unique identification tone for identifying the
consolidated e-mail received notification message(col.7 lines 1-67 and col.8 lines 55-62).

Regarding claim 26, Quinn teaches a method of notifying a voicemail receiver of an
event or other item of interest via voicemail messaging, comprising: constructing a first
notification message for notifying the voicemail receiver of the event or other item of
interest(col.7 lines 1-67 and col.8 lines 55-62);

annotating the first notification message with a unique identification tone for identifying the first notification message(col.7 lines 1-67 and col.8 lines 55-62);
transmitting the first notification message to a subscriber voicemail box;
locating the first notification message in the subscriber voicemail box via the unique identification tone; and modifying the first notification message(col.7 lines 1-67 and col.8 lines 55-62); .

Regarding claim 27, Quinn teaches the method of Claim 26, whereby modifying the first notification message includes deleting the first notification message(col.8 lines 23-62).

Regarding claim 28, Quinn teaches the method of Claim 26, whereby modifying the first notification message includes replacing the first notification message with a second notification message(col.8 lines 23-62; second notification message can be the same as first).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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